

reception system the objects which make up the application that
are derived by using [associated with] the identified table, and
executing the objects so as to present the corresponding text
and graphic data for review.

REMARKS

In the Official Action dated April 28, 1994, the Examiner objected to Applicants' disclosure on the grounds of grammatical informalities in claim 2, 11 and "elsewhere" and further, rejected Claims 1-15 under 35 U.S.C. §112, second paragraph, as "indefinite." Yet additionally, the Examiner also rejected Applicants' claims 1-15 under 35 U.S.C. 102(b) as being anticipated by U.S. patent 4,429,385 issued January 31, 1984 to Chichelli et al.

Concerning the Examiner's objection to Applicants' claims on the grounds of informalities, Applicants have reviewed their disclosure and entered amendments in the specification and claims to remove typographical and grammatical errors and to update the reference to their parent application which issued September 13, 1994, as U.S. patent 5,347,632. No new matter has been added. Accordingly, Applicants would respectfully submit that the Examiner's noted objections to their disclosure have been resolved.

Turning to the Examiner's rejection of Applicants' claims. As noted, the Examiner first rejected Applicants' claims 1-15 under 35 U.S.C. §112, second paragraph, as indefinite. Particularly, the Examiner asserts Applicants have

failed to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Applicants, however, must respectfully note that the Examiner's rejection is without foundation both as a matter of fact and as a matter of law and, accordingly must be withdrawn.

In formulating the rejection of Applicants' claims under §112, second paragraph, the Examiner has put forward a lengthy series of objections directed against the clarity of wording in each of Applicants' enumerated claims. However, on review of the Examiner's objections it is evident, the Examiner has declined to review Applicants' specification in detail and apparently has rather relied on a reading of the claims alone in an attempt to develop an understanding of them.

Applicants, however, would respectfully submit that this is improper and not in compliance with the continuously mandated test for assessing claim indefiniteness articulated by the Court of Appeals for the Federal Circuit and its predecessor the Court of Customs and Patent Appeals. Specifically, these Courts have repeatedly directed that the only test for claim indefiniteness under §112 is whether:

... one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, §112 demands no more.[emphasis added]

Miles Laboratories Inc. v. Shandon Inc., 27 U.S.P.Q.2d 1123, 1126 (Fed. Cir. 1993), citing *Orthokinetics Inc. v. Safety*

Travel Chairs Inc., 1 U.S.P.Q. 1081, 1088 (Fed. Cir. 1986) and *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 231 U.S.P.Q. 81, 94 (Fed. Cir. 1986).

As an illustration, in rejecting Applicants' claim 1, the Examiner notes: "it is not clear how locator differs from identifier to which it is 'indexed'." A reading of Applicants' specification, however, would show that the "locators" characterize the logical organization of the database and represent what the user sees when accessing the service of the preferred embodiment, while the "identifiers" characterize the physical organization of the database and represent what the system deals with in operation. As explicitly explained in Applicants' specification in connection with the preferred embodiment, the locators are keywords which the user knows and deals with as the names of the records; i.e., applications on the service, and the identifiers are object identifiers which the system deals with in accessing objects, the physical building blocks of the records; i.e., the applications of the interactive service.

As explained in Applicants specification:

In the preferred embodiment, the network includes procedures for creating preliminary searches which represent subsets of the network applications users are believed likely to investigate. Particularly, in accordance with these procedures, for the active applications available on network 10, a library of tables is prepared, and maintained within each of which a plurality of so called "keywords" are provided that are correlated with page template objects and object-ids of the entry screen (typically the first screen) for the respective application. In the preferred embodiment, approximately 1,000 tables are used, each having approximately 10 to 20 keywords arranged in alphabetical order to abstract the

applications on the network. Further, the object-id for each table is associated with a code in the form of a character string mnemonic which is arranged in a set of alphabetically sequenced mnemonics termed the sequence set so that on entry of a character string at an RS 400, the object-id for the relevant keyword table can be obtained from the sequence set. Once the table object-id is identified, the keyword table corresponding to the desired subset of the objects and associated applications can then be obtained from network 10. Subsequently the table can be presented to the user's RS 400, where the RS 400 can provide the data processing required to present the potentially relevant keywords, objects and associated applications to the user for further review and determination as to whether more searching is required. As will be appreciated, this procedure reduces demand on server 205 and thereby permits it to be less complex and costly, and further, reduces the likelihood of host overtaxing that may cause network response slowdown.

Specification, pg. 30, ln. 17 - pg.31, ln. 7.

Still further, a yet more detailed explanation of the particular steps associated with navigation in accordance with the method of the present invention can be obtained by reviewing the description of the multiple navigation procedures given in the specification at pg. 31, ln. 14 - pg. 36, ln. 31.

It is also to be noted that Applicants' claims are in so called "open form" the transitional term "comprising" having been used between the claim preamble and body. Accordingly, it is not to be expected that each and every element of the inventive method will be expressly recited in the wording of a claim. As such, the respective claims are understood to embrace the recited elements plus additional elements that might be included in the method. *Burke Inc. v. Everest & Jennings Inc.*, 29 U.S.P.Q.2d 1393, 1397, (Fed. Cir. 1993), *Parmelee Pharmaceutical Co. v. Zink*, 128 U.S.P.Q. 271, 275 (C.C.P.A. 1961).

With regard to the Examiner's uncertainty concerning claim 1 and the "set" a locator is "selected" from, as would be apparent from a reading of the claim in view of the above referenced sections of the specification, the locators are provided in the pre-created search table, the tables being referenced in claim 1 as code designated locator groups. Reference in this respect may also be made to claim 3.

Regarding the Examiner's concern over the use of the term "facilitates" in connection with recital of record retrieval, it is to be noted that since Claim 1 is in open form, the full details of the retrieval process need not be narrated, it being sufficient to note that description of the process as noted above is described in the specification.

As to the Examiner's objection to claim 2 regarding the absence of an antecedent for the term "the locators", plainly, reference is to the "record locators" previously recited. While Applicants would respectfully submit that each and every modifier of a claim element need not be repeated in subsequent references to the element in a claim, particularly when the claim is read in light of the specification, in the interests of moving prosecution forward, Applicants have undertaken amendment to aid understanding.

With regard to the Examiner's query concerning whether the locators in claim 3 are mnemonics, it is to be noted they are, as would be apparent for a reading of the specification as well as Claim 3 and claim 2 from which claim 3 depends.

Regarding the Examiner's uncertainty concerning the locators and identifiers referred to in claim 4, as is apparent from the cited sections of the specification above noted, the tables contain locators indexed to identifiers, the locators being the mnemonics; e.g., keywords.

As to the Examiner's objection to the word "arranging" as applied to the setting of locators as keywords, Applicants have undertaken appropriate amendment. Additionally, while the specification clearly explains use of the term strategies as applied to the multiple navigation procedures, Applicants have provided amendment for the sake of clarity.

With respect to the Examiner's question concerning claim 6, particularly as to how records can be interactive, Applicants would note that where the records are objects which define applications, as described in the specification, they may include data and code capable of supporting interaction.

Regarding the Examiner's questions concerning claim 10, Applicants would respectfully refer to their specification, particularly at pg. 31, ln. 13 to pg. 36, ln. 29 for a complete explanation.

Turning to the Examiner's question concerning Applicants' claim 11, amendment has been undertaken to provide clarification. However, with respect to the Examiner's reference to the origin of the table, once again Applicants would note their claims are in open form and need not recite each and every detail of their method. However, for a more

detailed description of the procedure, reference should be made to the specification.

With regard to claim 12, clarifying amendment has been undertaken and Applicant respectfully submit Claim 12 is in acceptable form.

As to claim 13, once again, Applicants would note that the procedure described in claim 13 is clear when read in the light of the specification, however, to aid understanding, Applicants have provided remedial amendment.

Finally, once again as to claims 14 and 15, Applicants would respectfully submit that the claims are clear when read in light of the specification, however, to advance prosecution amendments have been proposed.

In view of the above remarks and noted amendments, Applicants would respectfully submit that their claims when read in light of the specification are clear, definite and apprise one skilled in the art of their scope. Accordingly, Applicants would submit that the rejection of their claims under 35 U.S.C. §112, second paragraph is improper and must be withdrawn.

Turning next to the Examiner's rejection of Applicants' claims based on the prior art, Applicants would respectfully submit that here also the Examiner's analysis is defective both as to facts and the law, and, accordingly, the rejection must be withdrawn.

In rejecting Applicants' claims 1-15 under 35 U.S.C. §102(b) the Examiner contends Applicants claims are anticipated by Chichelli et al. A review of the Chichelli et al. teaching,

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however, show such a contention to be wholly without basis in fact. As noted above Applicants claims expressly recite steps for providing record locators indexed to record identifiers for the respective database records to be searched and retrieved. Further, Applicants claims call for the indexed locators and respective identifiers to be provided in groups that establish predetermined subset searches of the database records. As pointed out in Applicants' specification at pg. 30 ln. 16 - pg. 31, ln. 7, this approach has particular advantage in an interactive service as it reduces demand on the network resource for support and thus shortens response times and speed service performance.

Chichelli et al. provide not such teaching. Indeed, Chichelli et al. teach an entirely different approach to and entirely different service and database design. Chichelli et al. do not teach use of record locators indexed to respective record identifiers for the respective database records, or the grouping of locators and indexed identifiers in predetermined subset searches. In fact Chichelli et al. teach only the use of a record identifier for use in their record retrieval procedure.

Chichelli et al. refer to their database records as "frames" and note that the frames concern, in preferred form, classified advertising (col. 5, ln. 20 - ln. 22). Further, Chichelli et al. expressly state the logical organization of their database; i.e., the structure the user sees is hierarchical; i.e., many levels, and that the physical organization is serial sequential; i.e., a repeating,

SECRET 62035730

noninteractive broadcast carousel of frames. Further, Chichelli et al. teach only the use of a frame identifier to retrieve frames of data; i.e., records. As noted at col. 9, ln. 43 - 46, the frame identifier includes a frame number (24 bits), path (200 bits) and frame attributes (32 bits) to define the frame identifier.

Still further, Chichelli et al. neither discloses nor suggests use of predetermined subset searches of the database. Rather, Chichelli et al. propose the laborious and extended procedure of requiring the user to define a the frame identifier for a desired frame each time it is requested. Specifically, Chichelli et al. teaches that the user must generate the path portion of the frame identifier by moving through a sequence of hierarchical screens, selecting the categories of information sought and thereafter move through a relational screen to set the frame identifier attributes. Once this is done, the system software adds a frame number and supplies the identifier to circuitry that "grabs" the frames from the continuous stream (col. 8, ln. 37 - col. 9, ln. 64; col. 11, ln. 18 - col. 14. ln. 9; and Fig. 3A, 3B).

Chichelli et al. simply does not relate to Applicants' claimed invention. Indeed, the Examiner's efforts to fit the Chichelli et al. teaching into Applicants' claims in motivated solely buy hindsight and is wrong as a matter of technical fact. The Examiner refers to Chichelli et al. as including locators and identifiers and points to col. 8, ln. 43 - 44. That reference, however, is incorrect as it describes the information

content of the frame itself. As noted, Chichelli et al. refers only to a frame identifier which includes a frame number, path and attributes (col. 9, ln. 42 - 46). Further, the Examiner's reference to col. 8, ln. 15 - 16 is also mistaken. Though the Examiner maintained the reference is to arranging groups of locators, in fact no such description is provided. Indeed the noted reference concerns menu items in a teletex environment. Chichelli et al. simply has no teaching that discloses or suggest record locators indexed to record identifiers and no teaching that discloses establishment of groups of locators and identifiers in predetermined database subset searches. Thus, as a matter of law, Chichelli et al. can not anticipate Applicants' invention as claimed.

The Court of Appeals for the Federal Circuit (CAFC) and its predecessor, the Court of Customs and Patent Appeals (CCPA), have repeatedly held that for a prior art reference to anticipation a claimed invention under 35 U.S.C. §102, each and ever element of the claimed invention must appear in the single reference. *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (Fed Cir 1988). Further, the CAFC has pointed out that the elements of the claimed invention must be arranged in the reference as they are in the claimed invention in order to establish an anticipation. *Lindemann Maschinefabrik v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed Cir 1984).

Therefore, because Chichelli et al. has no suggestion of record locators or combined of record locators with record identifiers or arrangement of record locators and indexed identifiers in groups, chichelli et al. can not as a matter of

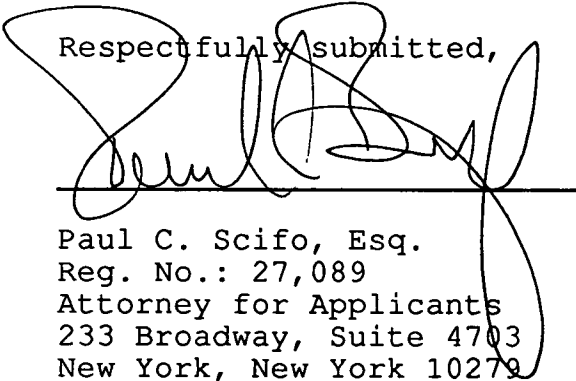
law be considered to anticipate applicants claims. Accordingly, the Examiner's rejections of claims 1-15 as anticipated under 35 U.S.C. §102(b) is erroneous and must be withdrawn.

However, while Applicants believe their invention as claimed is distinguished over the art, in an effort to further clarify those distinctions and to move their application to allowance, Applicants have proposed the clarifying amendments above noted. Support for the amendment of claim 1-15 can be found at least at pg. 29, ln. 16 - pg. 36, ln. 29.

Accordingly, in view of the noted amendments and preceding remarks, Applicants would respectfully submit that their invention is patentably distinguished from the art cited, and, that all objections raised by the examiner have been resolved. Therefore, Applicants, requests reconsideration of their application and issuance of a patent thereon.

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Respectfully submitted,


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, on October 28, 1994.

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